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James L Driessen
305 N 1130 E
Lindon, UT 84042

EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
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3625

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Please find below and/or attached an Office communication concerning this application or proceeding.

SW

Office Action Summary

Application No.

09/630,272

Applicant(s)

DRIESSEN, JAMES LEONARD

Examiner

Nicholas D. Rosen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6 and 8-13 is/are rejected.
- 7) ☒ Claim(s) 4 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

Claims 1-13 have been examined.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 2-12 been renumbered 3-13, respectively, since there were two claims numbered 2 by Applicant's numbering. The second of these is now the new claim 3.

Information for Pro Se Applicant

Examiner will fax Applicant guidelines on how to properly amend the claims and perhaps the specification, as discussed. No new matter should be entered. Applicant is invited to call Examiner at 703-305-0753 to discuss the application.

Oath/Declaration

A new oath or declaration is required because Applicant's residence is not expressly stated. A mailing address is given, but the residence address is not expressly stated to be the same. Both addresses (which may be identical) should be given explicitly, or else the Declaration may include the residence address explicitly, and give the post office address as "same as above."

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

The Declaration should include an explicit reference to provisional application 60/215,673, if priority to that provisional application is claimed.

The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Specification

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:
(1) if a machine or apparatus, its organization and operation;

- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it substantially exceeds 150 words in length. Also, the abstract should be on a separate sheet of paper. Correction is required. See MPEP § 608.01(b).

The "Font Fingerprinting" section of the specification contains examples of writing using different fonts. It is likely that should the application be issued as a patent, the distinctions would not be preserved in the printed specification. Therefore, Applicant may wish to consider incorporating the illustration of the use of multiple fonts for fingerprinting into a drawing.

Claim Objections

Claims 1-10 are objected to because of the following informalities: In claim 1, the various claim limitations should end in semicolons, instead of commas. The second last clause should be followed by the word "and" after the semicolon. The phrase "means for" should replace "means of". The clause beginning "said establishment acts" does not recite an element of the system, and so should not stand as a clause on its own; instead, it should be added to the previous clause, and corrected to read "wherein said establishment acts" or "said establishment acting". In the second line, "customer access point" should be "a customer access point". In the third line, "said customer" should be "a customer" to avoid antecedent basis problems. In the fourth line, "the specific URL information" should be "specific URL information" or "a specific URL information", to avoid antecedent basis problems. Appropriate correction is required.

Claim 2 is objected to because of the following informalities: Claim 2 refers to "Method of claim 1", which is incorrect, because claim 1 is a system claim. If claim 2 is to depend on claim 1, it should recite features of a system, not steps of a method. A claim should be one sentence; therefore the initial letters of clauses should not be capitalized, and there should not be a period after "free samples." The second last clause should be followed by the word "and" after the semicolon. Appropriate correction is required.

Claim 3 is objected to because of the following informalities: Claim 3 refers to "Method of . . . claim 1", which is incorrect, because claim 1 is a system claim. If claim 3 is to depend on claim 1, claim 3 should be clearly rewritten as a proper system claim.

Claim 3 fails to clearly set forth what comprises what; the media content may comprise first and second labels, but not the means for recording or writing code on the media content. The clause beginning "said machine only visible" does not recite an element of the system, and so should not stand as a clause on its own; instead, it should be added to the previous clause, and corrected to read "wherein said machine only visible . . . consists" or else "said machine only visible . . . consisting." Appropriate correction is required.

Claim 4 is objected to because of the following informalities: Claim 4 refers to "Method of . . . claim 1", which is incorrect, because claim 1 is a system claim. If claim 4 is to depend on claim 1, claim 4 should be clearly rewritten as a proper system claim. "Said first mark" and "said second label" lack proper antecedent basis in claim 4, or in claim 1, on which claim 4 depends. Appropriate correction is required.

Claim 5 is objected to because of the following informalities: Claim 5 refers to "Method . . . claim 1", which is incorrect, because claim 1 is a system claim. If claim 5 is to depend on claim 1, claim 5 should be clearly rewritten as a proper system claim. (Incidentally, "Method transfer" should be "Method of transfer" in any case.) Clauses should recite parts of a system, rather than steps of a method. Clauses should not begin with capital letters; clauses should end with semicolons instead of commas (except the last clause, which correctly ends with a period); and the second to last clause should have the word "and" after the semicolon. In the twelfth line of claim 5, "turning of cookies" should be "turning off cookies". In the thirteenth line of claim 5, "web delivered applet capabilities (e.g. JAVA)" is unclear because it does not clearly set

forth whether the web delivered applet capabilities are or are not limited to JAVA.

Appropriate correction is required.

Claim 6 is objected to because of the following informalities: Claim 6 refers to "Apparatus of Claim 1", which is incorrect, because claim 1 is a system claim. If claim 6 is to depend on claim 1, claim 6 should be clearly rewritten as a proper system claim. Claim 6 should specify what element in claim 1 (for example, "said customer access point") comprises a store, kiosk, etc. The use of "such as" makes the claim indefinite, since it is not clear whether the digital storage device is required to be a hard drive. Claim 6 is also apparently circular in that it recites a customer access point that comprises a customer access point. Appropriate correction is required.

Claim 7 is objected to because of the following informalities: Claim 3 refers to "Apparatus of Claim 1", which is incorrect, because claim 1 is a system claim. If claim 7 is to depend on claim 1, claim 7 should be clearly rewritten as a proper system claim. Claim 7 should specify what element in claim 1 (for example, "said customer access point") comprises a computer including a printer, etc. Also, while "transfer of ownership of Internet content" makes sense, "transfer or ownership of claim 1 of said Internet content" does not. Appropriate correction is required.

Claim 8 is objected to because of the following informalities: Claim 8 refers to "Means of claim 1." That should be, "The system of claim 1, further comprising means for . . ." or "The system of claim 1, further comprising a CD burner [or whatever is to be claimed]." Appropriate correction is required.

Claim 9 is objected to because of the following informalities: Claim 9 refers to "A method . . . of claim 1", which is incorrect, because claim 1 is a system claim. If claim 9 is to depend on claim 1, claim 9 should be clearly rewritten as a proper system claim. (Incidentally, "method transfer" should be "Method of transfer" in any case.) Appropriate correction is required.

Claim 10 is objected to because of the following informalities: Claim 10 refers to "A method . . . claim 1", which is incorrect, because claim 1 is a system claim. If claim 10 is to depend on claim 1, claim 10 should be clearly rewritten as a proper system claim. (Incidentally, "Method transfer" should be "Method of transfer" in any case.) Appropriate correction is required.

Claims 11 and 12 are objected to because of the following informalities: Claim 11 begins "Means for," which is unclear. The claim should be more clearly defined as a system claim, a method claim, a product claim (for a recording), or some other type of claim; then the claim elements should be placed in appropriate format (parts of a system, steps in a method, features of a product). In the second line of claim 11, "Individually" should not be capitalized. Also in the second line, the claim should be made grammatical by changing "which" to "in which" or "wherein". The clauses of the body of the claim should end in semicolons instead of commas (except for the last one, for which a period is correct), and at the end of the second last element, the semicolon should be followed by the word "and". Appropriate correction is required.

Claim 12 is objected to because of the following informalities: The reference to the "recording of claim 10" should be corrected to refer to claim 10 (or however the

claims may be renumbered). If claim 11 is to be a product claim, claim 12 should be written not just as "Product", but "The product of claim 11, wherein . . ." If claim 11 is to be, for example, a method claim, claim 12 could be written as "A product made according to the method of claim 11, wherein . . ." Appropriate correction is required.

Claim 13 is objected to because of the following informalities: Claim 13 begins "Means for," which sounds like an incorrect attempt at a system claim ("A system for doing thus-and-so, comprising: means for A; means for B; and means for C"), but what is recited is a set of steps, so claim 13 appears to be a method claim, and should be rewritten as such ("A method of providing . . . comprising the steps of:"). The claimed elements should be consistent: steps for a method claim, specified apparatus or "means for" in a system claim. In particular, the element beginning "said machine visible coded message" should probably be attached to the previous clause, and begin "wherein". Clauses in the body of the claim should end in semicolons (as opposed to commas, periods, or no punctuation at all), except that the last clause should end in a period (currently lacking). The second last clause should have an "and" after the semicolon. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification mentions a card being cookie-free, but does not describe writing a small amount of programming code to be placed on a card, computer diskette, or other means of record, such that the programming performs the functions of capturing current Web browsing cache content status; capturing a computer's current operating system recent document content status; temporarily turning off cache capability for web browsers; temporarily turning off cookies; temporarily turning off web delivered applet capabilities; returning cache content status, operating system status, cache capability settings, cookie enabling settings, or other settings changed by application to original state before application was run on said computer; and retrieving media content over a public computer network during such instance that (said) application (above) has adjusted the said security settings of said computer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry ("Chain Cultivates Farming Niche") in view of Kargman (U.S. Patent Application Publication 2003/0158790) and official notice. As per claim 1, Gentry discloses a purchasing system for Internet merchandise or media, said system comprising: a customer access point at a retail point of sale establishment (paragraph beginning "TCS is using its existing computer system"), wherein said establishment acts as a seller through an in-person transaction with said customer (ibid.). Gentry does not expressly disclose means for customer, seller, said establishment, or any other party to provide the specific URL information that is the sale location of Internet merchandise or content desired by the customer, but given that a sale over the Internet takes place, someone must provide the appropriate sale location information. Gentry does not disclose means for predetermining such URL that consists of a predetermined Internet transaction, but Kargman teaches predetermining a URL that consists of a predetermined Internet transaction (paragraphs 11 through 14). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include means for predetermining such a URL that consisted of a predetermined Internet transaction, for the stated advantage of allowing users to place orders with minimal effort on the part of the user (Kargman, paragraph 9).

Gentry does not expressly disclose means for accepting payment whether it be cash or credit, but official notice is taken that it is well known for businesses to accept

payment, both in the form of cash and in that of credit. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include means of accepting payment, whether cash or credit, for the obvious advantage of enabling sellers and/or retail establishments to receive payment for goods and services.

Gentry does not expressly disclose means of conducting purchase of Internet merchandise on behalf of said customer including entering payment from said establishment as an intermediate purchaser or other means of distribution to said establishment, but official notice is taken that it is well known for retail establishments to make payment as intermediate purchasers, or otherwise have merchandise distributed to said establishment (e.g., when a retailer orders a product not currently on the shelves in response to a customer's request). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have means of conducting purchase of Internet merchandise on behalf of said customer including entering payment from said establishment as an intermediate purchaser or other means of distribution to said establishment, for the obvious advantage of enabling merchandise to be ordered by an establishment likely to be known to the wholesaler or manufacturer, and possessing credit with the wholesaler or manufacturer.

Gentry discloses online sales (paragraph beginning "TCS is using its existing computer system"), from which means of storing, retrieving, or shipping of said Internet merchandise is inherent. Gentry does not disclose transferring ownership of said Internet merchandise by entering shipping address as desired by the customer unless it

is content which may be immediately downloaded, recorded, or access privileges given to said customer, but official notice is taken that it is well known to enter a shipping address in ordering goods over the Internet. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to enter a shipping address as desired by the customer unless the merchandise was digital content, for the obvious advantage of enabling merchandise to be shipped to the buyer's address.

As per claim 8, Gentry discloses that means for the establishment to store, ship, or receive, said Internet media might be performed by said customer, said establishment, original seller of the merchandise, or any other potential party not mentioned (paragraph beginning "TCS is using its existing computer system") (in the sense that someone on this broad list must be performing the action!).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry, Kargman, and official notice as applied to claim 1 above, and further in view of Durst et al. (U.S. Patent 5,933,829). Gentry does not disclose media content on a public computer network; creating or procuring a card, computer diskette, or other means of record; writing, inscribing, programming, or otherwise placing access information on the card, computer diskette, or other means of record without requiring access to a public computer network during the recording process whether or not access is actually made; and using said card, computer diskette, or other means of record as a location for stored information; however, Durst teaches all of this (Abstract; column 2, line 13, through column 4, line 18; column 8, lines 14-53), and also purchasing or other transfer

of ownership of said card, computer diskette, or other means of record through a retail transaction or giveaway of free samples without requiring access to a public computer network during said transfer (column 5, lines 13-23); physically transporting said card, computer diskette, or other means of record to a computer or other receiving device for a public computer network (Internet); using the card, computer diskette, or other means of record to retrieve said stored information; and using said stored access information for obtaining media content from a public computer network (Abstract; column 2, line 13, through column 4, line 18; column 5, lines 13-23; column 8, lines 14-53). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention, for the stated advantage of sparing users from having to manually enter URL's, and enabling them to have confidence in sending sensitive information.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry, Kargman, and official notice as applied to claim 1 above, and further in view of Morris (U.S. Patent 5,530,751). Gentry does not disclose first and second labels according to claim 3. However, Morris teaches a [second] label that is an only machine visible, audible, or otherwise detectable version of a serial number, coded license number, or other identifying mark, said machine only visible, audible, or otherwise detectable label consisting of a coded message capable of singularly distinguishing the content from other content of the same or similar type (column 2, lines 10-38; column 3, lines 28-65; column 4, lines 20-39), implying means for recording or writing said code on said media content for content fingerprinting purposes. Hence, it would have been obvious to one

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of ordinary skill in the art of electronic commerce at the time of applicant's invention to include a second label that is machine only detectable version of a serial number, etc., for the stated advantage of enabling the owner of the media content to protect his ownership rights.

Morris does not expressly teach a first visible, audible, or humanly detectable label version of a serial number, coded license number, or other identifying mark. However, Morris teaches distributing media content to customers in such physical forms as magnetic tape, compact disk, etc. (column 4, lines 20-26). Official notice is taken that it is well known for such physical objects as tapes, compact disks, etc. to have humanly detectable serial numbers, coded license numbers, or other identifying marks, on the objects themselves and/or their packaging. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the media content to have a first visible, audible, or humanly detectable label version of a serial number, coded license number, or other identifying mark, for such obvious advantages as detecting fraud by comparing the humanly visible serial number to the machine readable number, or simply using the humanly detectable serial number to determine where and when something was made, thus, for example, tracking the problems that led to the creation of defective products.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry, Kargman, and official notice as applied to claim 1 above, and further in view of the anonymous article, "Appearing Soon at a Store Near You: An A.T.M. for the Ears," hereinafter "Appearing Soon." Gentry does not disclose a store, kiosk, or other

customer access point with a computer with or without Internet access that includes a digital storage device such as hard drive, music, or other media content on said hard drive, a recording device such as but not limited to a CD burner, DVD burner, VHS tape recorder, or cassette tape recorder; however, "Appearing Soon" teaches kiosks including memories and CD burners (see entire article). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the customer access point to comprise a store, kiosk, or other customer access point with a computer with or without Internet access that includes a digital storage device such as hard drive, music, or other media content on said hard drive, a recording device such as but not limited to a CD burner, DVD burner, VHS tape recorder, or cassette tape recorder, for the stated advantage of enabling customers to custom make audio CDs.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry, Kargman, and official notice as applied to claim 1 above, and further in view of the anonymous article, "Appearing Soon at a Store Near You: An A.T.M. for the Ears," hereinafter "Appearing Soon." Gentry does not disclose transfer of ownership of Internet media by recording such media on a recording device and delivering to a customer at the location of said retail establishment, but "Appearing Soon" teaches that kiosks can be hooked into the Internet, and include CD burners for delivering CD's containing songs to a customer at the location of the retail establishment (whole article). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transfer ownership of Internet media by

recording such media on a recording device and delivering to a customer at the location of said retail establishment, for the obvious advantage of making a wide variety of songs and other media content available.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gentry, Kargman, and official notice as applied to claim 1 above, and further in view of Durst et al. (U.S. Patent 5,933,829). Gentry does not disclose transfer of ownership of Internet media by recording the URL information and a specific access code to the URL onto any device capable of storing said information, but Durst teaches URL information and an access code recorded onto a device capable of storing said information (Abstract; column 8, lines 14-53). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transfer ownership of Internet media by recording the URL information and a specific access code to the URL onto any device capable of storing said information, for the stated advantage of making the URL easy to refer to and reproduce accurately (Durst, columns 1 and 2).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris (U.S. Patent 5,530,751) in view of Petrovic et al. (U.S. Patent 5,940,135). Morris discloses a system for audio and/or video recording that includes the ability to dub, loop, mix, or otherwise add signals to existing content to individually identify a recording, wherein: said added signals are outside of the frequency range for human discernment (column 3, lines 28-64); said added signals are for the purpose of individually identifying the origin of the recording (column 2, lines 10-38); said added signals are a code such

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as binary or Morse (column 4, lines 27-39; column 5, lines 12-26); said added signals are looped, dubbed, mixed, digitally added, or otherwise added to a sound or video stream (column 4, lines 27-39); and said added sounds are individualized when added to multiple recordings of sound content that create technically different sound recordings which are essentially identical to the human ear (column 2, lines 10-38; column 3, lines 37-64). Morris does not disclose that said signals are generated as an analog signal, but Petrovic teaches adding analog signals for identifying a recording (column 2, line 55, through column 3, line 2; column 3, lines 49-67). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to have said signals generated as an analog signal, for the stated advantage of copy control (see column 1 of Petrovic).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris and Petrovic as applied to claim 11 above, and further in view of Nielsen (U.S. Patent 5,953,415). Morris does not expressly disclose using the product of audio and/or video recording according to claim 11 to determine licensing or serial number identification of materials over a public computer network (Internet), but Nielsen teaches fingerprinting media content with particular application to distribution on the Internet (Abstract; column 1, line 5, through column 2, line 27). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to have the product of recording used to determine licensing or serial number identification of materials communicated over the Internet, for the stated advantage of discouraging illicit copying and transmission of media content over the Internet.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris (U.S. Patent 5,530,751) in view of Nielsen (U.S. Patent 5,953,415). Morris discloses a method for providing a user identifier to identify one or more recipients of media content (content fingerprinting), comprising the steps of: creating a label, version number, serial number, coded license number, or other identifying mark (column 4, lines 20-39); converting the label, version number, serial number, coded license number, or other identifying mark to a machine-only visible/audible detectable version of serial number, coded license number, or other identifying mark (column 3, lines 28-65; column 4, lines 27-53; column 5, lines 12-26); dubbing, looping, programming, or otherwise placing said machine only visible/audible code onto previously existing media content (column 4, lines 27-39), wherein said machine visible label consists of a coded message capable of singularly distinguishing the content from content of the same or similar type (column 2, lines 10-38; column 4, lines 27-39), and said machine visible coded message is binary, Morse, or other discernable code form (column 5, lines 17-26). Morris discloses means of recording, writing; or otherwise placing said machine only visible/audible code on said media content (column 4, lines 40-65); and means of reading said machine only visible/audible code on said media content (column 4, line 66, through column 5, line 11). Morris does not expressly disclose that the media content is Internet media content, but Nielsen teaches fingerprinting media content with particular application to distribution on the Internet (Abstract; column 1, line 5, through column 2, line 27). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to apply the method of providing user identifiers for

media content to Internet media content, for the stated advantage of discouraging illicit copying and transmission of media content over the Internet.

Allowable Subject Matter

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and also rewritten to overcome all objections. **Note that the claim language must be supported by the disclosure. It is questionable whether claim 5 can be rewritten to set forth clearly the limitations distinguishing it from the prior art of record, while being properly supported by the disclosure.**

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Gentry, discloses a purchasing system for Internet merchandise, as set forth above with regard to claim 1. Morris (U.S. Patent 5,530,751) discloses individually coded identifying marks noticeable only by machine. Digital signatures to confirm that documents or other files are authentic are well known, as taught, for example, by Remus ("Digital Signatures: The Next Step in Electronic Commerce"). Immega (U.S. Patent Application Publication 2003/0140235) (which may not qualify as prior art in any case) discloses public/private key cryptography for confirming the delivery of e-mail. However, neither Gentry nor any other prior art of record discloses or reasonably suggests transfer of ownership of media content over the Internet, using a computer, the media content comprising an individually coded license, serial number, or other identifying mark through content fingerprinting that uses

a code visible or audible or otherwise noticeable only by a machine on a first mark that is a first private key of a first public/private key pair to indicate that said merchandise is authentic, and also a second label comprising a second private key of a second private/public key pair to authenticate the delivery of said media content.

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and also rewritten to overcome all objections.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Gentry, discloses a purchasing system for Internet merchandise, as set forth above with regard to claim 1. Durst discloses printing a ticket, card, paper, or other recorded media of access information, but neither Durst, Gentry, nor any other prior art of record discloses that printing the ticket, card, paper, etc., comprises transfer of ownership of Internet content.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brassil et al. (U.S. Patent 5,629,770) disclose a document copying deterrent method using line and word shift techniques. Williams et al. (U.S. Patent 5,899,700) disclose an embedded multimedia control code method and apparatus. Van Dusen (U.S. Patent 6,175,823) discloses an electronic gift certificate system. Jaisimha et al. (U.S. Patent 6,587,663) disclose a system and method for

regulating the transmission of media data. Murphy (U.S. Patent 6,615,247) discloses system and method for customizing a requested web page.

Schena et al. (U.S. Patent Application Publication 2001/0001854) disclose printed medium activated interactive communication. Silverbrook et al. (U.S. Patent Application Publication 2003/0093335) disclose a method and system for online purchasing using coded marks. Immega et al. (U.S. Patent Application Publication 2003/0140235) disclose a method for biometric encryption of e-mail (which may not qualify as prior art).

Takahashi (Japanese Published Patent Application 11-66152) discloses a merchandise distribution system.

Prosis ("How to Keep it a Secret") discloses private/public key cryptography with fingerprinting for authenticating documents. Remus et al. ("Digital Signatures: The Next Step in Electronic Commerce") discloses private/public key cryptography with fingerprinting for authenticating documents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

The new mailing address for the Patent Office is:

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As of May 1, 2003, the former addresses, Washington DC 20231 and P.O. Box 2327 Arlington VA 22202, should **not** be used.

Papers can be hand-delivered to the Technology Center 3600 receptionist, 7th floor, Crystal Park 5, 2451 Crystal Drive, Arlington VA 22202.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Nicholas D. Rosen

NICHOLAS D. ROSEN
PRIMARY EXAMINER

September 12, 2003